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WILMERHALE/BOSTON			LUONG, VINH	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/727,306	<b>Applicant(s)</b> WILSON, DOUGLAS B.	
	<b>Examiner</b> Vinh T. Luong	<b>Art Unit</b> 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-23, 25/20, 26, 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-19, 24/14, 25/14, 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/25/09</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Appendixes 1-3</u> .                   |

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1. A request for continued examination (RCE) under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 24, 2009 has been entered.
2. The restriction requirement and the election of the species of FIGS. 1, 3, and 4 in the parent application are carried over to the instant RCE. See MPEP § 819.
3. Claims 20-23, 25/20, 26, and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on January 30, 2006.
4. The terminal disclaimer filed on September 24, 2009 is proper and has been entered.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 14-19, 24, 25/14, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite since the phrase “rigid, semi-rigid or flexible or non-deformable” in claim 14 is inconsistent with the other claim limitations. It is unclear whether the phrase “rigid, semi-rigid or flexible or non-deformable” in claim 14 should be read as “rigid,

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semi-rigid or flexible or deformable” or not. See footnote 1 on page 2 of the Board decision on September 2, 2009.

7. Claims 14-17, 19/17, 24, and 27, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Anson (US 2,134,020).

Claim 14

Anson teaches a fatigue relieving/preventing apparatus associated with a steering wheel 10 for controlling a vehicle, comprising:

a first section 13 that connects to a peripheral portion of the steering wheel 10; and

a rigid, semi-rigid or flexible, or non-deformable second section 11 that connects to, and extends from the first section 13 at the peripheral portion of the steering wheel 10, the second section 11 extends from the first section 13 outward at an angle (see, e.g., angle  $\alpha$  in Fig. 8 of Appendix 1 hereinafter “App. 1”) to a plane (App. 1) across a front face of the steering wheel 10, the second section 11 for providing resting support for at least a portion (e.g., a hand) of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 11 is less than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 10 when pressure from the portion of the vehicular operator's body on the second section 11 is equal to or greater than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10.

Claim 15

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The steering wheel 10 includes a steering wheel 10 for controlling at least a nautical vessel, aircraft, or ground transportation vehicle.

Claim 16

The portion of the body supported by the second section includes at least a forearm, wrist, or hand.

Claim 17

The first section 13 extends a length of a predetermined peripheral portion of the steering wheel 10.

Claim 19/17

The first section 13 is deformable. See *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC 1969)(“Flexibility” and “rigidity” are relative terms, particularly since virtually anything will flex if enough pressure is applied to it.).

Claim 24

Each first section 13 is formed integral with the steering wheel 10. The term “integral” is sufficiently broad to embrace construction united by such means as fastening and welding. See *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973) and *In re Morris*, 43 USPQ2d 1753, 1757 (CAFC 1997).

Claim 27

The first section 13 is flexible, rigid, or semi-rigid, or non-deformable. See “flexible” in *Fredman v. Harris-Hub Co., Inc.*, *supra*.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 14, 18, 19/18, and 25/14, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Gemma (US 2002/0162416 A1 cited in European Search Report).

#### Claim 14

Gemma teaches a fatigue relieving/preventing apparatus associated with a steering wheel 12 for controlling a vehicle, comprising:

a first section (Appendix 2 hereinafter “App. 2”) that connects to a peripheral portion of the steering wheel 10 (Gemma, ¶¶ 24-26); and

a rigid, semi-rigid or flexible, or non-deformable second section 16, 26 that connects to, and extends from the first section (App. 2) at the peripheral portion of the steering wheel 12, the second section 16, 26 extends from the first section (App. 2) outward at an angle (see, e.g., angle  $\alpha$  in App. 2) to a plane (App. 2) across a front face of the steering wheel 12, the second section 16, 26 for providing resting support for at least a portion (e.g., a hand) of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 16, 26 is less than the pressure for deforming the second section 16, 26 out of interference with the vehicular operator's ability to operate the steering wheel 12, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 12 when pressure from the portion of the vehicular operator's body on the second section 12 is equal to or greater than the pressure for deforming the second section 12 out of interference with the vehicular operator's ability to operate the steering wheel 12. Gemma, ¶¶ 8 and 24-26.

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Claim 18

The second section 16, 26 includes at least two second sections 16, 26 that each connected to the first section (App. 2) at separate locations as seen in FIG. 1.

Claim 19/18

The first section (App. 2) is deformable since it is made of a soft flexible material, such as, rubber. Gemma, ¶ 24.

Claim 25/14

Each first section is detachable from the steering wheel. Gemma, ¶ 25.

10. Claim 14, as best understood, is further rejected under 35 U.S.C. 102(b) as being anticipated by Park (US 5,207,713).

Park teaches a fatigue relieving/preventing apparatus 10 associated with a steering wheel 1 for controlling a vehicle, comprising:

a first section 60 that connects to a peripheral portion of the steering wheel 1; and

a rigid, semi-rigid or flexible, or non-deformable second section 20 that connects to, and extends from the first section 60 at the peripheral portion of the steering wheel 1, the second section 20 extends from the first section 60 outward at an angle (see, e.g., angle  $\alpha$  in Fig. 2A of Appendix 3 hereinafter “App. 3”) to a plane (App. 3) across a front face of the steering wheel 1, the second section 20 for providing resting support for at least a portion (e.g., a hand) of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 30 is less than the pressure for deforming the second section 20 out of interference with the vehicular operator's ability to operate the steering wheel 1, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 1 when

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pressure from the portion of the vehicular operator's body on the second section 20 is equal to or greater than the pressure for deforming the second section 20 out of interference with the vehicular operator's ability to operate the steering wheel 1 (FIG. 7). Park, claims 1-15.

11. Applicant's arguments filed September 24, 2009 have been fully considered but they are not persuasive.

First, the obviousness-type double patenting rejection is withdrawn in view of Applicant's filing of the terminal disclaimer.

Second, Applicant contended that the bulbular-formed grip portion 11 of Anson does not provide "resting support" for the driver's body; that is provided by the driver's lap. Amend. p. 7.

At the outset, Applicant's claims are drawn to an apparatus, not a process of using. It is well settled that the claims drawn to an apparatus must distinguish from prior art in terms of structure rather than function. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997); *In re Danly*, 120 USPQ 528 (CCPA 1959); *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987); and MPEP § 2114. The Court in *Schreiber* has laid Applicant's arguments to rest by pointing out that: "[a]lthough Schreiber is correct that Harz does not address the use of the disclosed structure to dispense popcorn, *the absence of a disclosure relating to function does not defeat the Board's finding of anticipation.*" The Court in *Schreiber* emphasized:

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("*[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.*"). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

*where the Patent Office has reason to believe that a functional limitation asserted to be critical for*



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*establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.*

See also *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); *In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

Moreover, it is well settled that words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the applicant. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001); *Merck & Co. v. Teva Pharmaceuticals USA Inc.*, 73 USPQ2d 1641 (Fed. Cir. 2005); and *Phillips v. AWH Corp.*, 415 F.3d 1303, 1320 (Fed. Cir. 2005) *en banc* and MPEP § 2111.

In the instant case, the functional limitation asserted by Applicant is an inherent characteristics of the prior art Anso. In fact, as described in Anso's specification, the bulbular-formed grip portion 11 is comfortably gripped by the hand of the driver (Anso, p. 1, left col., ll. 26-43). When the driver's hand grips the portion 11, the driver's hand must place or lay his/her hand on the portion 11. The common dictionary, such as, *Merriam-Webster's Collegiate Dictionary* defines "rest" as "[t]o place on or against a support." Therefore, when the driver places his/her hand on the portion 11, the driver "rests" his/her hand on the portion 11 as evidenced by the ordinary and customary meaning of the term "rest" in dictionary. Simply put, Anson's second section inherently provides resting support for at least the hand, *i.e.*, the portion of the vehicle operator's body as claimed.

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For the reasons set forth above, Applicant's request to withdraw the anticipation rejection of claims 14-19, 24/14, and 27/14 based on Anson is respectfully declined as a matter of law.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/  
Primary Examiner, Art Unit 3656